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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Attorney Docket No.: 2950.27US01

Buckley et al.

Confirmation No.: 5623

Application No.: 09/435,748

Examiner: Mark Ruthkosky

Filed: November 8, 1999

Group Art Unit: 1745

For: BATTERIES WITH THIN ELECTRODES

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPEAL NUMBER 2005-1249

SUPPLEMENTAL REPLY BRIEF

Mail Stop Appeal Briefs - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

In response to the Office Action of September 23, 2005 and the Remand from the Board dated August 26, 2005, Appellants respectfully submit these further comments. Appellants are simultaneously submitting a Request to Reinstate the Appeal along with this Supplemental Reply Brief.

*Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 16-0631.*

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office, Fax No. 571-273-8300 on the date shown below thereby constituting filing of same.

Date

December 1, 2005

Peter S. Dardi

Peter S. Dardi

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### REMARKS

#### Rejection Under 35 U.S.C. § 112, Second Paragraph

The remand from the Board indicated on page 2, that the Examiner's Answer raised issues regarding the rejection of claim 78-89 for lack of Indefiniteness. The rejection of these claims was maintained in the Office Action of September 23, 2005. The grounds for the rejection were evidently the same as the other claims rejected under this section since there were no specific comments on claims 78-89. As such, Appellants' arguments over this rejection naturally extend to apply also to claims 78-89. The Examiner expanded the discussion relating to derivatives in the present Office Action. However, the Examiner did not specifically assert why a person of ordinary skill in the art could not determine what a derivative would be. This is a conventional chemical concept that a person of ordinary skill in the art can readily grasp.

Appellants respectfully maintain that the claims are perfectly clear and definite. Since the Examiner has not presented sound arguments why a person of ordinary skill in the art would not understand the scope of the claim terminology, the Examiner has not established *prima facie* indefiniteness.

#### Rejection Under 35 U.S.C. § 112, First Paragraph

The remand from the Board of August 26, 2005 indicated on page 5, full paragraph that Appellant's had not addressed the issues regarding "less than about 4.5 microns." Appellants' specification explicitly recites average electrode thicknesses of less than 10 microns and less than 5 microns and average separator thicknesses of less than about 5 microns, as well as other specific subranges. Based on these teachings, it is clear that a person of ordinary skill in the art would undoubtedly recognize that Appellants possessed average electrode and separator thicknesses "less than about 4.5 microns." Based the legal precedent that bind these proceedings as well as a common sense reading of Appellants' specification, Appellants' specification clearly

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satisfies the Written Description requirement for Appellants' pending claims as would be clearly recognized by a person of ordinary skill in the art.

Applicants' noted in their Reply Brief of January 14, 2005 that the Examiner did not address in the Examiner's Answer the legal standards for establishing Written Description. In the Office Action of September 23, 2005, the Examiner added on page 4 an irrelevant assertion of why Appellants may have amended the claims to insert the features at issue along with an unsupported assertion that the claimed features were not supported by Appellants' specification. However, the Examiner still has failed to address the proper legal standards relating to Written Description. Appellants strenuously maintain that a person of ordinary skill in the art would clearly recognize that Appellants possessed the presently claimed invention as of the filing date. Thus, the Examiner has clearly failed to establish *prima facie* lack of written description, and the Written Description requirement is clearly satisfied.

Obviousness Over Dansui et al.

In the Office Action of September 23, 2005, the Examiner extended the rejection for anticipation to an alternative obviousness rejection. Appellants incorporate by reference their discussions regarding the unobviousness of their claims with respect to related claims that can be found in Appellants' Supplemental Appeal Brief of July 23, 2004 and their Reply Brief of January 14, 2005. In summary, the Dansui patent does not teach, suggest or motivate Appellants' claimed invention. Not only does the Dansui patent not teach all of the claim elements, but the Dansui patent does not provide a reasonable expectation of success with respect to Appellant's claimed invention.

With all due respect, the Examiner seems to base all the obviousness rejections on motivation that comes from the Examiner's hindsight based on Appellants' specification. First, Appellants' do not claim a smaller battery or less capacity. Appellants claim thinner battery

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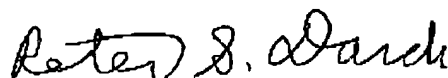
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components. The Examiner has not provided appropriate motivation in the art to form thinner battery components using submicron particle as claimed by Appellants. Furthermore, the Examiner has failed to provide any teachings in the art of suitable processes that can successfully make Applicants' claimed structures. Since the Examiner has failed to point to teachings of appropriate methods, the Examiner has not provided a reasonable expectation of success with respect to Appellants' claimed structures. Since the Examiner has failed to provide a reasonable expectation of success with respect to Appellants' claimed invention or provided motivation from the teachings in the art to form such structures with submicron particles, the Examiner simply has not established *prima facie* obviousness.

#### Summary

Appellants believe that they have addressed all remaining issues. The Examiner has not establishing *prima facie* unpatentability of any of Appellants' claims. Therefore, the rejections should be withdrawn, and Applicants respectfully request such action.

Respectfully submitted,



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